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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/334,891	06/17/1999	GUIDO GHISOLFI	32461/GM/IP	5842
42635	7590	01/26/2005	EXAMINER	
COBARR SPA P. O. BOX 590 6951 RIDGE ROAD SHARON CENTER, OH 44256			PATTERSON, MARC A	
			ART UNIT	PAPER NUMBER
			1772	
DATE MAILED: 01/26/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/334,891

Applicant(s)

GHISOLFI, GUIDO

Examiner

Marc A Patterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 36 and 44-51 is/are pending in the application.
- 4a) Of the above claim(s) 44-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Newly submitted claims 44 – 51 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The newly submitted claims are directed to a process for making a container, rather than a container.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 44 – 51 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

## **WITHDRAWN REJECTIONS**

2. The 35 U.S.C. 103(a) rejection of Claim 36 as being unpatentable over Roulin et al (U.S. Patent No. 5,508,075) in view of Harfmann (U.S. Patent No. 5,681,865) and Nankee et al (U.S. Patent No. 4,543,364), of record on page 3 of the previous Action, is withdrawn.

## **NEW REJECTIONS**

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Roulin et al (U.S. Patent No. 5,508,075) in view of Kimura et al (U.S. Patent No. 5,972,445).

With regard to Claim 36, Roulin et al disclose a container for food (column 3, lines 33 – 40) comprising a multi – layer material (column 6, lines 17 – 24) the material comprising a layer of a foamed sheet comprising polyester (column 3, lines 54 – 63), and, adhered to the foamed sheet, a film of polyester resin which is heat – sealable (column 3, lines 54 – 63); the film is coextruded (column 5, lines 62 – 65) the multi – layer material comprises creased lines (column 7, lines 4 – 14) which facilitate the folding of the material, and the container is obtained by folding (column 3, lines 63 – 66); however, the claimed aspect of the container being obtained by folding is directed to a product by process limitation and is therefore given little patentable weight, as Roulin et al disclose the structural limitations of the claimed container; the polyester film is made to adhere to the foamed sheet by hot lamination (heat sealing; column 6, lines 17 – 23). With regard to the claimed aspect of the polyester being ‘aromatic,’ Roulin et al teach the use of polyethylene terephthalate as a polyester of the invention (column 5, lines 13 – 19); the claimed aspect of the polyester being ‘aromatic’ therefore reads on Roulin et al. Roulin et al fails to disclose a foamed sheet having a density of less than  $700 \text{ kg/m}^3$  and a crystallinity lower than 15% and a heat sealable film having a crystallinity lower than 15% and a container that is recyclable.

Kimura et al teaches a multilayer sheet (column 3, lines 33 – 34) comprising multiple layers of polyester (column 3, lines 33 – 34) in which all of the layers which are made of polyester have a crystallinity of less than 15% (the degree of crystallinity of the multilayer sheet is not more than 15%; column 4, lines 16 – 18) and recyclable (column 1, line 14) for the

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purpose of obtaining a sheet that has good heat sealing property (column 4, lines 20 – 22). One of ordinary skill in the art would therefore recognize the advantage of providing for the crystallinity and recyclability of Kimura et al in all of the polyester layers of Roulin et al which comprises a multilayer sheet, depending on the desired heat sealability of the end product.

It therefore would have been obvious for one of ordinary skill in the art at the time Applicant's invention was made to have provided for a crystallinity of the layers of less than 15% and recyclability of Kimura et al in Roulin et al in order to obtain a sheet that has good heat sealing property as taught by Kimura et al

Kimura et al also fail to disclose a density of less than  $700 \text{ kg/m}^3$ . However, Kimura et al teach that the density of the sheet is selected depending on the desired crystallinity of the sheet (the degree of crystallinity is calculated from the value of amorphous density (column 4, lines 24 – 26). Therefore one of ordinary skill in the art would have recognized the utility of varying the density to obtain a desired range of crystallinity. Therefore, the crystallinity would be readily determined through routine optimization of density by one having ordinary skill in the art depending on the desired end use of the product.

It therefore would be obvious for one of ordinary skill in the art to vary the density in order to obtain a desired crystallinity, since the crystallinity would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end result as shown by Kimura et al.

Roulin et al also fail to disclose a polyester film having a melting point of 50 to 200 degrees Celsius. However, Roulin et al discloses a film having a melting point greater than 500 degrees Fahrenheit (column 6, lines 46 – 50) and teaches that the film is selected depending on

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the desired heat seal temperature (column 6, lines 46 – 50). Therefore, one of ordinary skill in the art would have recognized the utility of varying the melting point to obtain a desired heat seal temperature. Therefore, the heat seal temperature would be readily determined through routine optimization of melting point by one having ordinary skill in the art depending on the desired end use of the product.

It therefore would be obvious for one of ordinary skill in the art to vary the melting point in order to obtain a desired heat seal temperature, since the heat seal temperature would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end result as shown by Roulin et al.

Roulin et al also fail to disclose a container in which the heat sealable film comprises two layers. However, Roulin et al disclose a container in which the heat sealable film comprises one layer, as discussed above. It would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to have provided for additional layers, adhered to additional sides of the sheet, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

#### ANSWERS TO APPLICANT'S ARGUMENTS

5. Applicant's arguments regarding the 35 U.S.C. 103(a) rejection of Claim 36 as being unpatentable over Roulin et al (U.S. Patent No. 5,508,075) in view of Harfmann (U.S. Patent No. 5,681,865) and Nankee et al (U.S. Patent No. 4,543,364), of record in the previous Action, have

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been carefully considered but have not been found to be persuasive for the reasons set forth below.

Applicant argues, on page 7 of the remarks dated October 15, 2004, that Roulin et al does not indicate that in order to be foldable, a polyester core must be creased.

However, as stated above, the multi – layer material disclosed by Roulin et al comprises creased lines which facilitate the folding of the material, therefore the container is obtained by folding, and the container is obtained by folding; however, the claimed aspect of the container being obtained by folding is directed to a product by process limitation and is therefore given little patentable weight, as Roulin et al disclose the structural limitations of the claimed container.

Applicant also argues, on page 8, that Roulin et al do not disclose a foam having a crease because the structure of Claim 9 is used in the making of a bag.

However, Roulin et al clearly teach a foamed polyester that is foldable (column 7, lines 43 – 46) teach folding by the use of the creased lines as stated above, and therefore disclose the foam having a crease.

Applicant also argues, on page 4 of the supplemental remarks dated November 13, 2004, that it was previously stated that Claims 36 and 44 were in condition for allowance if amended.

However, no assurances regarding allowability were made, whether or not Applicant amended the claims in the manner indicated by Applicant.

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6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Patterson, whose telephone number is (571) 272 – 1497. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached at (571) 272 – 1498. FAX communications should be sent to (703) 872-9310. FAXs received after 4 P.M. will not be processed until the following business day.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished



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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pairedirect.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217 – 9197 (toll – free).

Marc A. Patterson, PhD.

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